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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of :

John N. OUSTERHOUT *et al.*

Serial No.: 10/019,920

Filed: June 24, 2002

)  
) Examiner: G. HARTMANN

)  
) Group Art Unit: 3671

)  
) Confirmation No. 7197

For: VEHICLE CAPTURE BARRIER

Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

PROVISIONAL ELECTION,  
TRAVERSE OF RESTRICTION REQUIREMENT  
and  
PETITION FOR ONE-MONTH EXTENSION OF TIME

In response to the restriction requirement of December 15, 2003 (the "office action"), the Applicants provide the following provisional election and hereby traverse the restriction requirement.

The shortened period for reply to the office action terminated one month from the mailing date thereof, namely, on January 15, 2004. As such, Applicants hereby petition for a one-month extension of time to extend the due date to February 17, 2004 (the 15<sup>th</sup> falling on a weekend, and the 16<sup>th</sup> falling on a federal holiday). The necessary fee of \$110.00 under 37 C.F.R. § .17(a)(1) is attached hereto. Any deficiency or overpayment of fees due in connection with the present application may be charged or credited to the undersigned's Deposit Account No. 50-0206.

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**Provisional Election**

Applicants hereby provisionally elect Group I, claims 1-12 and 19-21, for continued prosecution.

**Traverse**

Two requirements must be satisfied to enforce a restriction based on the distinctness of combination and subcombination inventions: (A) the combination as claimed does not require the particulars of the subcombination as claimed for patentability (to show novelty and nonobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations. *See* M.P.E.P. § 806.05(c). The M.P.E.P. defines the terms "combination" and "subcombination" as follows: "[a] combination is an organization of which a subcombination or element is a part." M.P.E.P. § 806.05(a).

The premise of the Examiner's restriction requirement is that the alleged "combination" of Invention II (claim 14 *et al.*) does not require the particulars of the alleged "subcombination" of Invention I (claim 1 *et al.*): "the combination as claimed does not require the particulars of the subcombination as claimed because Invention II does not require the claimed distances between the linking members and the median." Office Action p. 2. Applicant respectfully traverses this analysis for the following reasons.

To begin with, the Examiner appears to have reversed the combination/subcombination relationship between claim 1 (Invention I) and claim 14 (Invention II). As noted above, "a combination is an organization of which a subcombination or element is a part." M.P.E.P. § 806.05(a). As can be seen from attached Table 1, in which claims 1 and 14 are shown with common features underlined, claim 1 includes all of the functional features of claim 14, plus additional

features. Therefore, claim 14 is actually a subcombination of claim 1. In restriction terms, claim 14 is the "B" claim, while claim 1 is the "AB" claim.

Furthermore, combination claim 1 does not broadly recite the elements of subcombination claim 14, but instead recites them with the same degree of specificity with which they are recited in claim 14. That is to say, this is not a so-called "AB<sub>br</sub>/B<sub>sp</sub>" situation in which the subcombination is recited generally in the combination claim, but with greater specificity in the subcombination claim. As such, it can not be demonstrated that the subcombination (claim 14) is not essential to the combination (claim 1). Therefore, according to M.P.E.P. § 806.05(c)(I), restriction is improper.

Indeed, the present situation is more akin to that described in M.P.E.P. § 806.05(c)(II), in which the separately claimed subcombination (claim 14) constitutes the essential features of the combination claim (claim 1). That is, this is a "AB<sub>sp</sub>/B<sub>sp</sub>" situation. Accordingly, restriction is improper, regardless of any separate utility of the subcombination. See under M.P.E.P. § 806.05(c)(II) ("Where the relationship between the claims is such that the separately claimed subcombination B<sub>sp</sub> constitutes the essential distinguishing feature of the combination AB<sub>sp</sub> as claimed, the inventions are not distinct and a requirement for restriction *must not be made*, even though the subcombination has separate utility.") (emphasis added).

Applicants also note that independent claim 14 is not new to this prosecution, but is simply original dependent claim 14 rewritten in independent form. As such, it is not understood why rewriting this original claim in independent form has provoked an additional restriction requirement. Any issues regarding the distinctness of the inventions and the burden on the Examiner to search and examine the entire application were presumably resolved before the issuance of the first office action.

Conclusion

For at least the reasons outlined above, Applicants provisionally elect Invention I (claims 1-12 and 19-21), but respectfully traverse the restriction requirement. Should there be any questions regarding the foregoing, the Examiner is invited to contact the applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,  
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TABLE 1

CLAIM 1	CLAIM 14
<p>1. <u>A device for capturing a target vehicle travelling along a pathway, comprising:</u></p> <p><u>first and second support members (70A, 70B);</u></p> <p><u>a flexible barrier (20) which, with the device in at least a deployed condition, is held extending at least partially between said first and second support members at a height that is effective to engage the target vehicle as said target vehicle passes between the support members and having:</u></p> <p><u>an upper barrier member (22) extending generally horizontally across the pathway when the device is in the deployed condition;</u></p> <p><u>a lower barrier member (24) extending generally horizontally across the pathway when the device is in the deployed condition;</u></p> <p><u>a plurality of linking members (26, 28A, 28B, 30A, 30B) extending between the upper and lower barrier members and coupled to the upper and lower members effective to transfer a restraining force applied to at least one of the upper and lower members to the vehicle when the vehicle is engaged to the flexible barrier,</u></p> <p><u>wherein on either side of a barrier median, in at least an area starting about a foot (0.3 m) from the median and continuing to at least about four feet (1.2 m) from the median measured along the lower barrier member, each of the linking members extends between the upper and lower barrier members other than parallel to the median when the device is in the deployed condition and leave one or more large gaps in the barrier effective so that a vehicle tire overriding the lower barrier member and any lower portion of any linking member will encounter such a gap and, thereby be unable to draw the barrier beneath the vehicle to drive over the barrier.</u></p>	<p>14. <u>A device for stopping a target vehicle travelling along a pathway on a terrain surface, characterized by:</u></p> <p><u>first and second support members (70A, 70B); and</u></p> <p><u>a flexible barrier (20) held between the first and second support members and having upper (22) and lower (24) members and a plurality of linking members (28A, 28B, 30A, 30B) extending between the upper and lower members, wherein the linking members (28A, 28B, 30A, 30B) are angled relative to a median of the barrier when the device is in a deployed condition so that, upon engagement of a tire of the target vehicle with such a linking member, the tire will not be able to ride along such linking member to the upper member when the vehicle normally impacts the barrier.</u></p>